REMARKS

This responds to the Final Office Action mailed May 1, 2008 , the Advisory Action mailed on July 29, 2008 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed on September 12, 2008. This response includes a Request for Continued Examination under 37 C.F.R. 1.114 to reopen prosecution from an Appeal that was requested with a notice of appeal mailed on July 31, 2008.

Claims 1, 24, 34, and 36 are amended, no claims are canceled, claims 38 and 39 are added; as a result, claims 1-39 are now pending in this application.

Claim Amendments

Support for amendments to the independent claims 1, 24, 34, and 36 and the new claims 38 and 39 is found in paragraph 39 and Figure 13. Applicants submit that no new matter has been added to the application.

§102 Rejection of the Claims

Claims 1-37 were rejected under 35 U.S.C. § 102(e) for anticipation by Boesch et al. (U.S. Patent No. 5,897,621, hereinafter; "Boesch").

Applicants respectfully submit that the rejection of claims 1-37 under 35 U.S.C. § 102(e) is defective for the reason that Boesch does not disclose each and every limitation of the independent claims of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Independent claims 1, 24, 34 and 36

Applicants believe that the issue of patentablity of the independent claims 1, 24, 34 and 36 over Boesch is best understood with regard to claim 24.

Claim 24, as amended, includes the following limitations:

...the recipient communicator to communicate a user interface to the recipient to inform the recipient via the communications network about the payment in the sender-selected currency...

...the user interface to enable a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance the payment in the sender-selected currency and a denial of the payment in the sender selected currency.

The Final Office Action relies upon Boesch, which fails to disclose a *"the user interface to enable a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance the payment in the sender-selected currency and a denial of the payment in the sender selected currency."* Boesch states:

SUMMARY OF INVENTION

The present invention is directed to a system for determining approval of a transaction between a merchant and a customer. The system comprises a merchant device associated with the merchant. The merchant device has a first set of data including a product price in a first currency The system also has a customer device associated with the customer. The customer device has a second set of data including a first amount in a second currency. The system further has a server device connected to both the customer device and the merchant device for receiving the first and second sets of data and for approving the transaction when the first amount in the second currency is within a risk range of the price in the first currency in accordance with current exchange rates.[1]

The quote from Boesch relates to a system. The system comprises a merchant device, a customer device, and a server. The merchant device has a first set of data including a product price in a first currency. The customer device has a second set of data including a first amount in a second currency. The server receives the first and second sets of data and approves the transaction based on a current exchange rate. Specifically, the server approves the transaction

---

[1] Boesch, Summary of Invention.

when the first amount in the second currency is within a risk range of the price in the first

currency according to the current exchange rate.

The Final Office Action relies upon the following quotes from Boesch:

> The present invention is directed to approval of multi-currency transactions in which the customer user 203 pays in a first currency and the merchant user 303 accepts the payment in a second currency which differs from the first currency.[2]

> ....Thus, the merchant user 303 will accept a price and receive payment for the product sold to the customer user 203. The price for the product is in a currency accepted by the merchant user 303, referenced herein as the "price in the merchant accepted currency P(MAC)". The customer user 203 will pay an amount to the merchant user 303 for a selected product. The amount will be paid in a currency selected by customer user 203, referenced herein as the "amount in the customer selected currency A(CSC)". The currency selected by the merchant user 303 is different than the currency selected by the customer user 203. Hence, currency exchange is used to approve the transaction contemplated by the present invention.[3]

The above two quotes from Boesch relate to a "multi-currency transaction." [4] The

"multi-currency transaction" includes different first and second currencies. Boesch identifies the

"first currency" as a "customer selected currency A(CSC) and the "second currency" as a

"merchant accepted currency P(MAC)." The first currency is selected by the customer who pays

an amount for a product in the customer selected currency. The second currency is accepted by

the merchant who receives a price for the product in the merchant accepted currency. In another

quote Boesch explains, "the customer user 203 and the merchant user 303 do not bear the above-

described risks associated with currency exchange."[5] Rather, "It is the entity charged with

performing actual settlement of the transaction who bears such risks when the transaction is

actually settled." [6]

---

[2] Boesch, col. 6, lines 63-68.
[3] Id., col. 7, lines 7-18.
[4] Id., col. 6, lines 11-19.
[5] Id., col. 6, lines 53-57.
[6] Id., col. 6, lines 60-63.

Claim 24 requires "*a recipient communicator to communicate a user interface to [a]*

recipient. " Claim 24 further requires the "*user interface to enable a receiving of a selection from*

the recipient, the selection from the recipient is selected from a group consisting of an

acceptance of the payment in the sender-selected currency and a denial of the payment in the

sender selected currency. " In contrast, the above quote from Boesch relates a merchant device,

a customer device, and a server device, the "server device... for approving the transaction when

the first amount in the second currency is within a risk range of the price in the first currency..."

Boesch explains:

> One aspect of the invention disclosed herein shifts the risk associated with currency
> exchange from both the merchant and customer to a third party (e.g., a server) in real
> time. This server may assume the risk itself or may choose to subsequent pass on the risk
> to a firth party (e.g., bank or other financial institution).

Boesch relates a system whereby neither the customer nor the merchant approve the transaction.

Rather, the *server* approves the transaction. Specifically, the server approves the transaction

based on a currency exchange because "the price for the product is in a currency accepted by the

merchant user" [7] and the amount for the product that is paid by the customer is "in a currency

selected by customer user." [8] Boesch therefore cannot be said to anticipate the above quoted

limitation because Boesch relates a "system [that] has a server device ...for approving the

transaction when the first amount in the second currency is within a risk range of the price in the

first currency in accordance with current exchange rates" [9] and claim 24, as amended, requires a

"a *recipient communicator to communicate a user interface to [a] recipient,* " the "*user interface*

to enable a receiving of a selection from the recipient, the selection from the recipient is selected

from a group consisting of an acceptance the payment in the sender-selected currency and a

denial of the payment in the sender selected currency. " These are distinguishable actions.

---

[7] Id., col. 7, lines 8-9.
[8] Id., col. 7, lines 11-12.
[9] Id., Summary of Invention, col. 1, line 63 - col. 2, line 2.

In summary, because Boesch does not disclose each and every limitation of amended claim 24, it fails to make a *prima face* showing of anticipation as is required to support a rejection of this claim under 35 U.S.C. § 102(e).

The above remarks are also applicable to a consideration of amended independent claims 1, 34, and 36, since each of those claims includes limitations that are substantially similar to the distinguishing limitations of claim 24.

Since the rejection of each of the dependent claims 2-23 and 25-30 under 35 U.S.C. § 102(e) is defective for the same reasons as was the rejection of independent claims from which they depend, it is respectfully submitted that the rejection of all of the claims be withdrawn.

Independent claims 13, 31, 35 and 37

Applicants believe that the issue of patentablity of the independent claims 13, 31, 35 and 37 over Boesch is best understood with regard to claim 31.

Claim 31 includes the following limitations:

> *...a recipient decision determinator to receive from the recipient via the communications network data indicating a recipient decision with respect to an acceptance of the payment in the sender-selected currency...*

Claim 31 requires "*a recipient decision determinator to receive from the recipient via the communications network data indicating a recipient decision with respect to an acceptance of the payment in the sender-selected currency...*" In contrast, the above quote from Boesch relates a merchant device, a customer device, and a server device, the "server device... for approving the transaction when the first amount in the second currency is within a risk range of the price in the first currency..." As mentioned above, Boesch relates a system whereby neither the customer nor the merchant approve the transaction. Rather, the *server* approves the transaction. Boesch therefore cannot be said to anticipate the above quoted limitation because Boesch relates a "system [that] has a server device ...for approving the transaction when the first amount in the second currency is within a risk range of the price in the first currency in accordance with current

AMENDMENT, RESPONSE & RCE UNDER 37 CFR § 1.114
Serial Number: 10/608,525
Filing Date: June 26, 2003
Title: MULTICURRENCY EXCHANGES BETWEEN PARTICIPANTS OF A NETWORK-BASED TRANSACTION FACILITY

Page 16
Dkt: 2043.114US1

exchange rates" [10] and claim 31 requires a "*a recipient decision determinator to receive from the recipient via the communications network data indicating a recipient decision with respect to an acceptance of the payment in the sender-selected currency....* " These are distinguishable actions.

The above remarks are also applicable to a consideration of independent claims 13, 35, and 37, since each of those claims includes limitations that are substantially similar to the distinguishing limitations of claim 31.

Since the rejection of each of the dependent claims 32 and 33 under 35 U.S.C. § 102(e) is defective for the same reasons as was the rejection of independent claims from which they depend, it is respectfully submitted that the rejection of all of the claims be withdrawn.

---

[10] Id., Summary of Invention, col. 1, line 63 - col. 2, line 2.

AMENDMENT, RESPONSE & RCE UNDER 37 CFR § 1.114
Serial Number: 10/608,525
Filing Date: June 26, 2003
Title: MULTICURRENCY EXCHANGES BETWEEN PARTICIPANTS OF A NETWORK-BASED TRANSACTION FACILITY
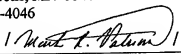
Page 17
Dkt: 2043.114US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
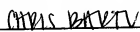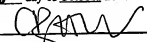
Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4046

Date   October 16, 2008   By _____
                                      Mark R. Vatuone
                                      Reg. No. 53,719

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this ___ day of October 2008.

_____   _____
Name   Signature